

R E M A R K S

- Claims 1 and 36 – 40 are pending in the present application.
- Upon entry of this amendment, which is respectfully requested, claims 1 and 36 – 40 will remain pending, independent claim 1 will be amended and independent claims 41 – 46 will be added.

I. Claims 1, 36, 37

Claims 1 and 37 were “rejected under 35 U.S.C. 102(b) as being anticipated by Gerfin, U.S. Patent No. 3,735,982.” (pg. 2 of paper 6). Claim 36 was “rejected under 35 U.S.C. 103(a) as being unpatentable over Gerfin in view of Dabrowski, U.S. Patent No. 5,531,440.” (pg. 3 of paper 6).

Claim 1, from which claims 36 and 37 depend, has been amended to recite the limitation that the period of time which expires “is measured from a time of player selection of the subject game element having the first class.” Such a feature is not taught or suggested by either Gerfin or Dabrowski, alone or in combination. In Gerfin the period of time disclosed is a period of time that a player has to select a playing card. The period of time disclosed in Gerfin ends once a player selects a card or a card is selected for the player. In the embodiment of claim 1 as amended the period of time commences upon player selection of a game element. Thus amended claim 1 is patentable over Gerfin and the combination of Gerfin and Dabrowski and claims 36 and 37 are patentable at least because they include the limitations of claim 1.

II. Claims 38 and 39

Claims 38 and 39 were rejected “under 35 U.S.C. 103(a) as being unpatentable over Gerfin in view of Hung.” (pg. 4 of paper 6). Examiner states that it “would have been obvious to one of ordinary skill in the art at the time the invention was made to include a countdown timer display in the invention of Gerfin. Countdown timers are well known as in Hung.” There is nothing in either Gerfin or Hung that teaches or suggests the combination of the two references to produce Applicants’ invention. Gerfin pertains to the field of card playing machines while Hung pertains to the field of manually operated timers. Examiner did not present a motivation to combine the two references as found either implicitly or explicitly in the references themselves. Therefore, Applicants respectfully assert that Examiner’s rejection of claim 38 (and claim 39 which is dependent from claim 38) was improper because Examiner did not make out a prima facie case of obviousness.

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” (MPEP §2143.01). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (MPEP §2143.01) See, for example, *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998), where the combination of the

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references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.

Even if Gerfin and Hung were combined the combination would not result in the embodiment recited by the limitations of claims 38 and 39. The timer taught by Hung requires that players playing a chess game "alternately operate a second pair of switches...to direct the signals to countdown terminals." In the embodiment of Applicants invention represented by claims 38 and 39 a countdown timer is not manually operated or reset by a player. Further, claim 38 recites "expiration of the first class corresponding to the subject game element." Hung only teaches a timer that counts down a period of time during which a player must complete his or her move in a game of chess. Thus, Hung does not teach or suggest a timer that counts down the specific feature explicitly recited in claim 38 and thus the combination of Gerfin and Hung do not teach or suggest the claimed limitation. Applicants respectfully request that Examiner withdraw the 103(a) rejection of claims 38 and 39 based on Gerfin in view of Hung.

### III. Claim 40

Claim 40 was rejected "under 35 U.S.C. 102(b) as being anticipated by Gerfin." (pg. 2 - 3 of paper 6). Examiner asserts that in Gerfin "[t]he player may actuate a lock button to prevent the subject game element, i.e. card, from expiring."

Applicants disagree with Examiner's characterization of Gerfin. Gerfin teaches that play of video poker wherein a player "has a predetermined time limit (30 seconds) during which he must energize push button switches...before the machine automatically stops play." In Gerfin playing cards flash in sequence and the player has a predetermined amount of time to select one of the flashing cards or one will automatically be selected for him. Once a player selects a card within the predetermined time period, the clock stops running. (col. 3, ll 37 - 42 and ll 52 - 55; col. 4, ll 2 - 5). Thus a card in Gerfin does not "expire" after a predetermined amount of time but rather is selected for a player after a predetermined amount of time. Gerfin does not teach or suggest the limitation of claim 40 of "actuating a lock button to prevent the subject game element from expiring." Since Gerfin does not teach or suggest every feature of the rejected claim, Applicants respectfully request that Examiner withdraw the §102(b) rejection of claim 40.

### IV. New claims 41 - 46

Newly presented claims 41 through 46 are each an independent apparatus or article of manufacture claim that correspond to claims 1, 38 and 40. No new matter has been added.

**Conclusion and Petition for Extension of Time to Respond**

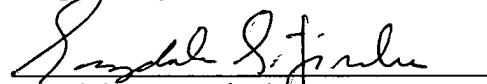
For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested. Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461-7041 or via electronic mail at mfincham@walkerdigital.com.

Applicants believe a one-month extension fee of \$110.00 is due with this response. Applicants hereby petition for an extension of time with which to respond to the Office Action and authorize a \$110.00 fee charge to our Deposit Account No. 50-0271. Please charge any fees that may be due for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271. A duplicate copy of this authorization is attached for such purpose.

If an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271. A duplicate copy of this authorization is attached for such purpose.

January 4, 2002

Respectfully submitted,



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**CLAIM AMENDMENTS: VERSION WITH CHANGES MARKED**

Please **SUBSTITUTE** the following claim 1 for the pending claim of the same number:

1. (TWICE AMENDED) A method for directing a computing device to conduct a game of chance, the method comprising the steps of:
  - generating a subject game element having a first class;
  - displaying the subject game element, thereby displaying an indicia of the first class;
  - in response to expiration of a period of time that is measured from a time of player selection of the subject game element having the first class, assigning a second class to the subject game element; and
  - displaying the subject game element, thereby displaying an indicia of the second class.

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